

REMARKS

I. Status of Claims

Claims 1-13 are pending in the application. Claim 1 has been amended to delete "potato extract" and "avocado extract." By this amendment, no new matter has been added and it is believed that the claims are now in condition for allowance.

II. Information Disclosure Statement

The Examiner did not consider the Information Disclosure Statement filed January 23, 2002, because a copy of a search report from the European Patent Office was not included. Although Applicants believe a copy of the International Search Report was submitted with the IDS of January 23, 2002, Applicants re-submit a copy of this IDS with a copy of the Search Report. Accordingly, Applicants respectfully request that the Examiner consider the references cited in the IDS of January 23, 2002.

III. Claim Rejections under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter, in this case a method of protecting keratinous fiber from extrinsic damage, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. See M.P.E.P. § 2131.

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A. Ruiseco

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Ruiseco* (U.S. Patent No. 4,849,214) ("*Ruiseco*") for the reasons set forth on pp. 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

Ruiseco provides an oil based composition made by placing grated avocado seed in a mineral oil solution for a period of time. See Abstract.

In an effort to expedite prosecution, claim 1 has been amended to delete "avocado extract." Applicants submit that *Ruiseco* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Ruiseco* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Greff

Claims 1 and 10-12 stand under 35 U.S.C. § 102(b) as being anticipated by *Greff* (FR 2 740 331) ("*Greff*") for the reasons set forth on pp. 4-5 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner states that *Greff* teaches a composition comprising extracts of *Solanum tuberosum*, or potato extract. Page 3 of Office Action. While Applicants do not believe that *Greff* clearly teaches such a composition, in an effort to expedite prosecution claim 1 has been amended to delete "potato extract" thus rendering this rejection moot. Applicants submit that *Greff* does not disclose a composition

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comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Greff* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

C. Leip

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Leip* (U.S. Patent No. 285,045) ("*Leip*") for the reasons set forth on page 5 of the present Office Action. Applicants respectfully traverse this rejection.

Leip describes a composition prepared by steeping potatoes and straining the liquid product.

Again, in an effort to expedite prosecution Claim 1 has been amended to delete "potato extract." Applicants submit that *Leip* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Leip* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

D. Product Alert (U)

Claims 1 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Product Alert (U)* (Frederic Fekkai Technician Conditioner) ("*Product Alert (U)*") for the reasons set forth on p. 5 of the present Office Action. Applicants respectfully traverse this rejection.

Product Alert (U) describes a Technician Conditioner formulated with botanical extracts such as apricot and avocado.

In an effort to expedite prosecution, claim 1 has been amended to delete "avocado extract." Applicants submit that *Product Alert (U)* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Product Alert (U)* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

E. Yamagata

Claims 1-3 and 10-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Yamagata* (JP 01190622) ("*Yamagata*") for the reasons set forth on p. 5-6 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that *Yamagata* teaches a shampoo treatment including avocado oil, implying that avocado oil is the same as an avocado extract. Pp. 5-6 of Office Action. Applicants traverse this characterization of avocado oil as an extract, and have previously submitted text from the International Cosmetic Ingredient Dictionary and Handbook, Eighth Edition, 2000, which shows that essential oils are different components from extracts as understood in the cosmetic arts. See Supplemental Response dated April 9, 2002. Because the avocado oil of *Yamagata* is not an extract, *Yamdagata* fails to teach an avocado extract.

Nevertheless in an effort to expedite prosecution, claim 1 has been amended to delete "avocado extract." Applicants submit that *Yamagata* does not disclose a

composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Yamagata* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

F. Salinas

Claims 1 and 10-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Salinas* (U.S. Patent No. 5,665,342) ("*Salinas*") for the reasons set forth on page 6 of the present Office Action. Applicants respectfully traverse this rejection.

Salinas describes a cosmetic formulation prepared by boiling in water a composition containing potato peelings and lantana leaves. See Abstract.

In an effort to expedite prosecution, claim 1 has been amended to delete "potato extract." Applicants submit that *Salinas* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Salinas* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

G. Carson et al.

Claims 1-4, 6-7, and 10-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Carson et al.* (U.S. Patent No. 5,416,075) ("*Carson et al.*") for the reasons set forth on pp. 6-7 of the present Office Action. Applicants respectfully traverse this rejection.

Carson et al. discloses a composition that can include avocado oil. Col. 8, l. 3. Applicants, however, traverse the Examiner's characterization of avocado oil as an extract, and contrary to the Examiner's assertion the Applicants have previously submitted text from the International Cosmetic Ingredient Dictionary and Handbook, Eighth Edition, 2000 to demonstrate that an essential oil is considered a different ingredient from an extract in the cosmetic arts. See Supplemental Response dated April 9, 2002.

The Examiner also states that she does not find this argument persuasive because the specification does not "exclude plant essential oils as plant extracts." Page 7 of Office Action. Applicants contend that one of ordinary skill in the art would readily understand that plant essential oils do not include plant extracts, in light of the disclosure in the International Cosmetic Ingredient Dictionary and Handbook, which forms the industry standard classification. Thus, it is not necessary that the specification disclose that which is already understood in the art. Because the avocado oil of *Carson et al.* is not an avocado extract, *Carson et al.* fails to anticipate the present claims.

Nevertheless, in an effort to expedite prosecution, claim 1 has been amended to delete "avocado extract." Applicants submit that *Carson et al.* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Carson et al.* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

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H. Shah

Claims 1-3 and 10-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Shah* (EP 681 826) ("*Shah*") for the reasons set forth on pp. 7-8 of the present Office Action. Applicants respectfully traverse this rejection.

According to the Examiner, *Shah* describes a "shampoo composition comprising wheat oligosaccharides and wheat germ extract (hydrolyzed wheat protein and wheat amino acids)." Page 7 of Office Action.

The Applicants respectfully disagree with the Examiner's characterization that *Shah* describes a wheat germ extract of hydrolyzed wheat protein and wheat amino acids. *Shah* discloses a composition comprising hydrolyzed wheat protein, wheat oligosaccharides, wheat amino acids, and panthenol. Page 4, l. 17-18. This description conveys that only the purified forms of these ingredients are used. See also Example 1, p. 6, l. 30-32.

The term "extract" has an accepted meaning in the art of cosmetics, as evidenced by its usage in the International Cosmetic Ingredient Dictionary and Handbook. Specifically, plant extracts are classified as "Biological Products" at p. 1646 (attached herewith). Plant extracts are also classified under "Botanicals," which are "cosmetic ingredients directly derived from plants... [g]enerally, these ingredients have not undergone chemical modification and include extracts..." (printout from CD-ROM entry attached herewith).¹

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¹ Printout from CD-ROM of the International Cosmetic Ingredient Dictionary and Handbook, 8th Edition, CTFA Scientific/Regulatory 2000.

From this classification, an extract is not a purified form of a specific ingredient. Thus, *Shah* does not describe the use of a wheat germ extract but rather the use of purified forms of certain ingredients that may be included in an extract.

For at least this reason, Applicants submit that *Shah* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

I. Wolf et al.

Claims 1-3 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Wolf et al.* (U.S. Patent No. 5,443,855) ("*Wolf et al.*") for the reasons set forth on p. 8 of the present Office Action. Applicants respectfully traverse this rejection.

Wolf et al. describes a composition comprising extensins. See Abstract. Certain extensins can be obtained by exposing small pieces of potato to water. See Example 3, col. 6, l. 33-39. *Wolf et al.*, however, teaches using extensin solutions from potato for use in makeup or eyeshadow and not for the application to keratinous fiber. For example, *Wolf et al.* teaches shampoos and hair conditioners comprising extensin solutions from corn. See Examples 9 and 10, col. 7, l. 53 to col. 8, l. 24.

Nevertheless, in an effort to expedite prosecution, claim 1 has been amended to delete "potato extract." Applicants submit that *Wolf et al.* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Wolf et al.* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

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J. Sakai

Claims 1-3 and 10-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Sakai* (JP 03284615) ("*Sakai*") for the reasons set forth on pp. 9-10 of the present Office Action. Applicants respectfully traverse this rejection.

Nevertheless, in an effort to expedite prosecution, claim 1 has been amended to delete "potato extract." Applicants submit that *Sakai* does not disclose a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

For at least this reason, Applicants submit that *Sakai* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

K. Konishi

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Konishi* (JP 62099319) ("*Konishi*") for the reasons set forth on pp. 11-12 of the present Office Action. Applicants respectfully traverse this rejection.

Konishi teaches a hair tonic comprising an extract of mistletoe to promote hair growth. The Examiner alleges that "the referenced compositions are clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair." Page 11 of Office Action.

The Applicants respectfully disagree. The mere disclosure of "hair tonic," does not clearly convey that the composition is applied to the hair. In fact, *Konishi* states that the hair tonic is "safe for the human body without skin irritation." By stating that the tonic is safe for the skin, *Konishi* teaches that the tonic is to be applied to the skin or the

scalp and not to the hair. Thus, *Konishi* does not teach use of its tonic for protecting keratinous fiber from extrinsic damage.

For at least this reason, Applicants submit that *Konishi* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

L. Lekim

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Lekim* (DE 3901286) ("*Lekim*") for the reasons set forth on pp. 11-12 of the present Office Action. Applicants respectfully traverse this rejection.

Lekim teaches a hair tonic comprising an alcoholic extract of mistletoe for reducing or stopping hair loss. The Examiner alleges that "the referenced compositions are clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair." Page 11 of Office Action.

The Applicants respectfully disagree. The mere disclosure of "hair tonic," does not clearly convey that the composition is applied to the hair. Hair tonics for promoting hair growth are applied to the scalp. It does not make sense that one would apply a tonic to hair for stimulating hair growth. It must be applied to the scalp. Without a further disclosure that the hair tonic of *Lekim* is necessarily applied to the hair, *Lekim* fails to qualify as a reference under 35 U.S.C. § 102.

For at least this reason, Applicants submit that *Lekim* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

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IV. Claim Rejections under 35 U.S.C. § 103

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. See M.P.E.P. § 2143. Evidence of a suggestion or motivation to modify or combine references teachings must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

A. Sakai

Claims 1-3 and 10-11 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Sakai* (JP 03284615) ("*Sakai*") for the reasons set forth on pp. 9-10 of the present Office Action. Applicants respectfully traverse this rejection.

As discussed previously, *Sakai* teaches a hair tonic comprising an extract consisting essentially of saccharide and protein of natural yam. *Sakai*, however, fails to teach an extract applied to hair. The Examiner supports the § 103 rejection on the basis that the composition of *Sakai* is similar to that of the present claims.

The Applicants submit, however, that the Examiner has failed to provide a *prima facie* case of obviousness because *Sakai* fails to provide "clear and particular" evidence of a motivation to apply the composition to hair.

Nevertheless, in an effort to expedite prosecution, claim 1 has been amended to delete "potato extract." Applicants submit that *Sakai* does not teach a composition comprising at least one plant extract chosen from mistletoe extract, wheat germ extract, and willowherb extract, as recited in amended claim 1.

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For at least this reason, Applicants submit that *Sakai* does not render obvious the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Konishi

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Konishi* (JP 62099319) ("*Konishi*") for the reasons set forth on pp. 11-12 of the present Office Action. Applicants respectfully traverse this rejection.

As described above, *Konishi* teaches a hair tonic comprising an extract of mistletoe to promote hair growth. *Konishi*, however, fails to teach applying the composition to the hair. *Konishi* states that the hair tonic is "safe for the human body without skin irritation." This statement suggests that the tonic is to be applied to the skin or the scalp and not to the hair. Thus, the hair tonic of *Konishi* is not used for protecting keratinous fiber from extrinsic damage.

The Examiner supports the § 103 rejection on the basis that the composition of *Konishi* is similar to that of the present claims.

The Applicants submit that the Examiner has failed to provide a *prima facie* case of obviousness because *Konishi* fails to provide "clear and particular" evidence of a motivation to apply the composition to hair. If anything, *Konishi*, suggests that the composition should be applied to the skin or scalp.

For at least this reason, Applicants submit that *Konishi* does not render obvious the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

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C. L kim

Claims 1 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Lekim* (DE 3901286) ("*Lekim*") for the reasons set forth on pp. 11-12 of the present Office Action. Applicants respectfully traverse this rejection.

As described above, *Lekim* teaches a hair tonic comprising an alcoholic extract of mistletoe for reducing or stopping hair loss. *Lekim*, however, fails to teach applying the composition to the hair.

The Applicants respectfully disagree with the Examiner's allegation that the compositions of *Lekim* "are clearly envisaged to be used as a hair tonic wherein the composition is applied to the hair." As described above, the mere disclosure of "hair tonic," does not clearly convey that the composition is applied to the hair. Hair tonics for promoting hair growth must be applied to the scalp to promote hair growth. Without such "clear and particular" evidence that *Lekim* suggests applying the tonic to the hair, as required by *Dembiczak*, the Examiner has failed to provide a *prima face* case of obviousness.

For at least this reason, Applicants submit that *Lekim* does not render obvious the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

D. Combination Rejection

Claims 1-8 and 10-13 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ruiseco* (U.S. Patent No. 4,849,214), *Greff* (FR 2 740 331), *Leip* (U.S. Patent No. 285,045), *Product Alert (U)* (Frederic Fekkai Technician Conditioner), *Yamagata* (JP 01190622), *Salinas* (U.S. Patent No. 5,665,342), *Carson et al.* (U.S.

Patent No. 5,416,075), *Shah* (EP 681 826), *Wolf et al.* (U.S. Patent No. 5,443,855), *Sakai* (JP 03284615), *Konishi* (JP 62099319), and *Lekim* (DE 3901286) in view of *Pineau et al.* (U.S. Patent No. 6,296,856) for the reasons set forth on pages 12-15 of the present Office Action. Applicants respectfully traverse this rejection.

First the application of *Ruiseco*, *Greff*, *Leip*, *Product Alert (U)*, *Yamagata*, *Salinas*, *Carson et al.*, *Wolf et al.*, and *Sakai* in this rejection is moot in light of amended claim 1, which no longer recites "potato extract" and "avocado extract."

The Examiner concedes that none of the references teach a composition comprising the recited sugars and relies on *Pineau et al.* to provide a teaching of sugars. Page 13 of Office Action.

The Examiner supports the combination of references because "it is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition," and cites *In re Pinten*, *In re Susi*, and *In re Crockett*.

Pineau et al. is primarily focused on combating aging of skin. See abstract. The only disclosure of a hair application is a teaching of polyholosides, which may be used "in particular into compositions for use on the hair. The remaining references, *Konishi* and *Lekim*, teach a hair tonic, and *Shah* teaches a shampoo.

Applicants contend that the Examiner is applying *In re Pinten*, *In re Susi*, and *In re Crockett* much more broadly than their holdings allow. In *Pinten*, the appealed claims related to a combination of specific surfactants for preparing phenolic resin foams. The court found the claims obvious because the prior art taught that both specific surfactants were known for preparing polyurethane foams. *In re Pinten*, 459

F.2d 1053, 1054 (CCPA 1972). Moreover, the court found the surfactants of the primary reference to be “so closely related” to the surfactants of the secondary reference. *Id.* at 1053.

In *Susi*, the claims at issue were directed to stabilizing polymers with a specific additive. *In re Susi*, 169 U.S.P.Q. 423, 425 (CCPA 1971). The prior art taught the stabilization of plastics with a compound having a very similar formula, where the court found only “one difference which... seems to be of little importance.” *Id.* (“Knapp shows a hydroxyl group attached to the benzene ring which is absent in appellant’s formula...”).

Finally, in *Crockett*, the Appellants’ claims were directed to graphitic carbon wholly or partly in the form of nodules via “supplying to a bath of molten cast iron a stream of inert gas carrying a major proportion of finely divided calcium carbide and a minor proportion either of magnesium oxide...” *In re Crockett*, 279 F.2d 274, 276 (CCPA1960). The art taught that both magnesium oxide and calcium carbide, individually, promoted the formation of a nodular structure in cast iron. *Id.* The court found the combination unobvious because “the idea of combining them would flow logically from the teaching of the prior art. *Id.*

Thus, all three cases hold obvious the combination of very closely related compounds used to achieve the very same purpose. Here, the Applicants are not claiming very closely related compounds, but extracts and the claimed sugars for protection of keratinous fiber. The cited art, in contrast, teaches using these extracts and sugars for very different purposes. Certainly, *Pineau* does not teach sugars to promote hair growth or for use in a shampoo, nor does *Shah*, *Konishi*, or *Lekim* teach

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the use of extracts to combat aging of the skin (Applicants maintain that *Shah* does not even teach an extract).

It is telling that the Examiner could not find one disclosure of using the claimed sugars among the long list of references cited to show the use of extracts. Moreover, extracts and sugars are hardly "closely related" compounds. Because the references teach very different compounds for very different purposes, *In re Pinten*, *In re Susi*, and *In re Crockett* are inapplicable here.

Applicants' case presents facts more similar to that of *In re Geiger*, where the Board similarly held it prima facie obvious to combine the three components together for their known functions and to optimize the amount of each. *In re Geiger*, 815 F.2d at 687-88, 2 U.S.P.Q.2d at 1277-78. However, the Federal Circuit reversed the Board, emphasizing that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Id.* at 688, 2 U.S.P.Q.2d at 1278. While acknowledging that combining the three components of the claimed composition may have been obvious to try, the court stated it does not constitute the standard for combining references under § 103. *Id.*; cf. *In re Wesslau*, 353 F.2d at 241, 147 U.S.P.Q. at 393 (holding "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art").

Thus, the Examiner is effectively ignoring the well-established standard of patent law, i.e. there must be some objective teaching in the prior art, coupled with the

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knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify reference teachings with a reasonable expectation of success in obtaining the claimed inventions. See, M.P.E.P. § 2143.01; 2143.02. No case cite can rebut this requirement. As the Examiner has failed to supply the requisite suggestion or motivation to combine, the Examiner has failed to provide a *prima facie* case of obviousness.

Accordingly, for at least the foregoing reasons, Applicants respectfully request that this rejection be withdrawn.

V. Provisional Double Patenting Rejection

Claims 1-13 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/527,599 for the reasons set forth on pp. 15-16 of the present Office Action. Applicants respectfully traverse this rejection, but, at this time, respectfully request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

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VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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APPENDIX OF CLAIMS

1. (Amended) A method of protecting keratinous fiber from extrinsic damage comprising

applying to said keratinous fiber a composition comprising at least one plant extract chosen from [potato extract,] mistletoe extract, [avocado extract,] wheat germ extract, and willowherb extract.

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